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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/875,871

06/07/2001

Dwip N. Banerjee

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05/02/2006

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EXAMINER

HOLZEN, STEPHEN A

ART UNIT

PAPER NUMBER

3644

DATE MAILED: 05/02/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>		<b>Applicant(s)</b>	
	09/875,871		BANERJEE ET AL.	
	<b>Examiner</b>		<b>Art Unit</b>	
	Stephen A. Holzen		3644	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 February 2006.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 and 18-31 is/are pending in the application.
- 4a) Of the above claim(s) 19-31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 and 18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Newly submitted claims 19-25 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Method and apparatus inventions are distinct if it can be shown that the process as claimed can be practiced by hand (MPEP § 806.05(e)). In this case the apparatus provides machine instructions that a computer automatically follows, while the method can be accomplished through either coded operation or input-process-output operation.

Input-process-output operation = after data has been manually input into one of the program buffers from a manual device (keyboard), it is processed, the results are displayed to a manual user who manually enters further input or manually initiates an electronic information transfer.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

2. Newly submitted claims 26-31 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons:

3. In this case the apparatus provides machine instructions that a computer automatically follows, while the method can be accomplished through either coded operation or input-process-output operation.

The inventions are distinct if it can be shown that the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the computer system (which comprises a seller computer and a buyers computer linked over a network) can be used to play on-line blackjack. In the alternative, the computer to computer network need not actually accomplish the method as claimed and instead the sellers computer can be waiting for a purchase order from a buyer. The materially different process then can be summarized as a "method of waiting for a purchase order". It should be appreciated that the apparatus need not actually be in use, or be used at all. It would be anticipated by any two computers linked together capable of transmitting information back and forth.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 19-25 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

4. Claims 1-6 and 18-31 are pending
5. Claims 19-31 have been withdrawn.
6. Claims 1-6, and 18 have been acted on.

***Response to Arguments***

7. Applicant's arguments filed 2/13/2006 have been fully considered and they are persuasive. The applicant has amended the claims such that they are limited to information transmitted over a network / through a computer. Harrington does not teach using a computer to transmit information and therefore does not anticipate this claim.
8. The 101 rejection has been withdrawn.

***Claim Rejections - 35 USC § 103***

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-3, and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington "New Trade terms you need to know" (Harrington).

Re – claim 1: The disclosed invention is a method of arranging shipments according to a buyer's preference. Specifically, the currently claimed invention is directed towards a method comprising a buyer selecting a delivery agent, and coordinating the delivery of goods directly with the delivery agent. Further the claim invention comprises the step of informing the seller that the buyer has coordinated the delivery of goods and that a delivery agent has been assigned.

The seller makes these goods available for pick up for the by buyers preferred agent.

Claim 1 is essentially a method comprising three steps:

Step 1: A seller receiving an order from a buyer,

Step 2: Allowing the buyer to choose a delivery agent

Step 3: The seller makes the goods available for pick-up by said buyers preferred delivery agent.

On page 61 of the May addition of "Traffic Management" Lisa Harrington discloses (in an article titled: "New Trade Terms you need to know") that it is well known in the art for a seller to receive an order from a buyer, allowing the buyer to choose a delivery agent (see page 2 of attached print out, lines 15-17), and that the seller makes the goods available for pick-up by the buyer's preferred delivery agent (see page 2 of the attached print out, lines 8-13, where Harrington discloses that the seller "has fulfilled his obligation to deliver when he has made the goods available at his premises).

It is the examiner's position then that Harrington discloses each of every claimed limitation of the presently claimed invention, as defined in claim 1 (with the exception of doing this method over the internet).

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Harrington does not disclose practicing steps 1-3 (as defined above) over a network.

It has been decided that merely providing an automatic means to replace a manual activity, which accomplishes the same results, is not sufficient to distinguish over the prior art. *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958).

Furthermore MPEP 2106 reminds "[M]erely using a computer to automate a known process does not by itself impart nonobviousness to the invention. See *Dann v. Johnston*, 425 U.S. 219, 227-30, 189 USPQ 257, 261 (1976); *In re Venner*, 262 F.2d 91, 95, 120 USPQ 193, 194 (CCPA 1958)."

It would have been obvious to one having ordinary skill in the art, at the time the invention was made to automate the process of providing at least a buyer preferred delivery option over the internet for the purpose of decreasing order processing lag times.

Re – Claim 2: Harrington does not specifically disclose communicating the shipping information such as (1) an identification of goods and (2) time and place for pickup. However this information is inherent in the disclosure of Harrington. Ex-Works shipping terms require that the buyer be responsible for coordinating

deliver of the goods from the suppliers premise, and therefor inherently the buyer would need to coordinate an identification of the goods and a time and place for pick between the supplier and the delivery agent. "Ex-works" is a trade term specifying a contractual agreement involving international transportation. Ex works is a trade term that refers to clauses in contracts that outline matters such as the time and place of delivery and payment, the time when the risk of loss shifts from the seller to the buyer and the party who pays the costs of freight and insurance. Inherently Harrington discloses the limitations of claim 2, by disclosing that Ex-works is a known trade term.

Re – claim 3: This claim is similar to claim 2, except is further limited by the step of the buyer transmitting the shipping information to the delivery agent. This step is also inherent in the Harrington disclosure. Since the seller obligations are fulfilled by providing the goods to whatever delivery agent the buyer chooses, it would be up to the buyer to arrange for the delivery. At the very least it is inherent that the buyer would verify that the delivery agent has the proper information before the delivery agent would go to pick up the goods.

Re – claim 6: The vendor would be receiving additional information regarding the buyer's delivery agent. Such information includes licenses, certificates, insurance, the liability of loss, the division of costs and taxes. These are all common obligations and risks between the buyer and seller and delivery agents.

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and inherently any transcontinental buyer, vendor and delivery agent would exchange this information for the purpose of defining the scope of responsibility for each party.

10. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington in view of Pool (6,460,020). Harrington does not specifically disclose splitting out the cost of the goods from the shipping costs. Pool (6,460,020) however does disclose that it is known to provide the price of the goods "Ex-works" as a separate line item (see Col. 14, lines 30+ #16). It would have been obvious to one having ordinary skill in the art, at the time the invention was filed, to split out the shipping costs, insurance costs and the price of the goods, since doing so would provide the buyer a means for gauging the relative prices between different suppliers.

11. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington in view of Williams (2002/0032573). Harrington discloses every aspect of the present invention, as disclosed above, however does not specifically provide information to the buyer that would lead the buyer to select a specific carrier. Williams however does provide information to the buyer that would lead the buyer to select a specific delivery agent. The Williams reference teaches that a buyer can be presented with the names of various delivery agents for the buyer's convenience. This information leads to the eventual choosing of a delivery agent based on the information provided by the vendor. It would have been obvious to one having ordinary skill in the art at the time

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the invention was made for the vendor (seller) to provide information about various delivery agents that the vendor prefers, thus leading the buyer to choose one of said various delivery agents for the purpose of strengthening business relationships between vendor and agent.

12. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Harrington as applied to claim 1 above, and further in view of Duncan (6,934,692). Duncan discloses that it is known for a buyer to receive information related to the arrangement of shipping costs over a network. Specifically Duncan discloses a buyer of goods (205), delivering the product to the buyer (226), collecting payment (227), where payment may be due at the time of delivery of the request (e.g., the product) to the buyer. For example, at least one of the clearinghouse or the shipper may request payment from the buyer upon confirmation of delivery. (Col. 7, lines 35-50). It would have been obvious to one having ordinary skill in the art to arrange the buyer to pay the shipper over a network for the purpose of increasing efficiency.

### ***Conclusion***

13. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stephen A. Holzen whose telephone number is 571-272-6903. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Teri Luu can be reached on 571-272-7045. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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A handwritten signature in black ink, appearing to read 'Teri Pham Luu', with a stylized flourish at the end.

**TERI PHAM LUU  
SUPERVISORY  
PRIMARY EXAMINER**